

**REMARKS/ARGUMENTS**

Applicants submit this Amendment in reply to the Office Action mailed March 26, 2004.

In this Amendment, Applicants cancel claims 1 and 38 and amend claims 34, 35, 44, 48 and 53 to improve clarity. Claim 34 was amended to incorporate the subject matter of claim 38 and claim 48 was amended to incorporate the subject matter of claim 53. Before entry of this Amendment, claims 1 and 34-66 were pending in this application. After entry of this Amendment, claims 34-37 and 39 -66 are pending in this application.

The originally-filed specification, claims, abstract, and drawings fully support the amendment of claims. No new matter was introduced.

In the Office Action, the Examiner rejected claims 34-37, 45-52, and 60-62 under 35 U.S.C. § 102(b) as being unpatentable under U.S. Patent No. 1,407,839 to Clinefelter et al. (“Clinefelter”); rejected claims 38-44, 53-59, and 63-66 under 35 U.S.C. § 103(a) as being unpatentable over Clinefelter; and rejected claims 1, 34-37, 39, 43-54, and 61-66 under the judicially created doctrine of obviousness-type double patenting in view of U.S. Patent No. 6,332,999 to Caretta. Applicants respectfully traverse the Examiner’s rejections for at least the reasons discussed below.

Claim 1 has been canceled and claim 34 has been amended to incorporate the subject matter of cancelled claim 38, and claim 48 has been amended to recite the subject matter of claim 53. Claims 35 –37, 40-42, 44, 46, 47 and 53 were amended to improve readability and consistency.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 34-37, 45-52, and 60-62 have been rejected under 35 U.S.C. § 102(b) as being unpatentable under U.S. Patent No. 1,407,839 to Clinefelter. Applicants respectfully disagree with the rejection. However, to advance prosecution of the above-captioned application, Applicants have amended claim 34 to recite a method of moulding and curing tyres, including an expanding step in which fluid under pressure is admitted, and, prior to the expanding step, a lower pressure fluid is admitted between the outer surface of the toroidal support and the inner surface of the tyre (hereinafter referred to as the “preforming step”). Applicants have also amended claim 48 to recite an apparatus for moulding and curing tyres, comprising at least one guide duct extending along an inner surface of a toroidal support.

Clinefelter does not disclose or suggest “*before the expanding step, an admitting step*” which “is carried out by admission of a fluid between the outer surface of the toroidal support and the inner surface of the tyre.” (emphasis added). In column 4, lines 5-15, Clinefelter teaches placing the tyre in a vulcanization mould and immediately thereafter passing pressurized fluid through an aperture in order to expand the tyre. Clinefelter is entirely silent as to the claimed method “wherein said expanding step includes a step of admitting a fluid under pressure, and, before the expanding step, admitting a working fluid between the outer surface of the toroidal support and the inner surface of the tyre, wherein the working fluid is under a lower pressure than that of the fluid under pressure admitted during the expanding step.”

Moreover, as shown in Figures 1-3, Clinefelter teaches that fluid under pressure is introduced into a chamber (2) via a conduit (5) and then passed straight through an aperture (3). Clinefelter does not teach the use of a guide duct for the fluid under pressure, and therefore at

least fails to teach the expanding step including “admitting fluid under pressure, which is guided ... *through a guide duct*,” (emphasis added) as recited in amended claim 34. In addition, Clinefelter fails to teach the claimed combination including the at least one guide duct, as recited in amended claim 48.

Accordingly, in view of the above-described deficiencies of Clinefelter, Applicants respectfully submit that claims 34 and 48 are allowable over the applied reference. In addition, claims 35-37 and 45-47 are allowable at least due to their dependence from claim 34, and claims 49-52 and 60-62 are allowable at least due to their dependence from claim 48.

Claim Rejections Under 35 U.S.C. § 103(a)—Independent Claims

Applicants submit that independent claim 34 and 48 are patentable under 35 U.S.C. § 103(a) and are not obvious over Clinefelter. Applicants note that claim 34 has been amended to include subject matter of claim 38 requiring a preforming step prior to expansion. Additionally, applicants note that claim 48 has been amended to include subject matter of claim 53 requiring guiding fluid under pressure through a guide duct.

Applicants respectfully submits that the Examiner’s contention that the claimed preforming step would have been obvious is impermissible hindsight. In fact, the Examiner does not specifically address the reason why the preforming step is obvious in the rejection of claim 38. Rather, the Examiner merely states that “using steam to perform both the expansion and the heating of a tire is certainly well known and would have been an obvious modification to the process and apparatus of Clinefelter et al to streamline the vulcanization.” Office Action, p. 3. However, claim 34 further requires a distinct step of admitting fluid under a lower pressure than that of the fluid under pressure admitted during the expanding step prior to the expanding step.

Applicants respectfully submit that a motivation for this specific step is not provided in the Office Action.

In rejecting claim 38, the Examiner argues without citation to any specific teachings in Clinefelter or any other references that the preshaping of the tire is one of the “aspects” that “would have been well within the skill level of the art,” and would have been an “obvious modification to the delivery system shown in Clinefelter.” Office Action, p.3. Thus, the Examiner apparently acknowledges that the preforming step is not disclosed in Clinefelter, but the Examiner contends that the preforming step would somehow have been obvious. Applicants respectfully disagree, and to the extent the Examiner’s assertion constitutes “Official Notice,” Applicants note that pursuant to M.P.E.P. § 2144.03 “the notice of facts beyond the record which may be taken by the examiner must be capable of such instant and unquestionable demonstration as to defy dispute. It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” M.P.E.P. § 2144.03, internal citations omitted, emphasis in original.

Moreover, a February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding “Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice states, “[i]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” Memorandum, p. 3. Here, Applicants respectfully submit

that the Examiner has improperly made generalized statements without any supporting documentary evidence in formulating the rejection under § 103.

Moreover, in rejecting claim 53 under 35 U.S.C. § 103, the Examiner contends that “the guide ... would have been an obvious modification,” (Office Action, p.3) without citation to any specific teachings in Clinefelter or any other references in support thereof. Thus, the Examiner apparently acknowledges that the claimed guide duct is not disclosed in Clinefelter. Nevertheless, the Examiner reaches the unsupported conclusion that the claimed guide duct would have been obvious without identifying prior art for the position set forth in the Office Action.

Applicants respectfully submit that the Examiner’s conclusions based on common knowledge without further support by the record are improper. Noting the impropriety of such actions, as the Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.” Memorandum at 1. Applicants respectfully request that “[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is ‘basic knowledge’ or ‘common sense’.” *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the 35 U.S.C. § 103(a) rejection after considering the arguments presented herein, Applicants respectfully submit that the Examiner must provide “the explicit basis on which the examiner regards the matter as subject to official notice and [allow Applicants] to challenge the assertion in the next reply after the Office action in which the

common knowledge statement was made.” Memorandum at 3, emphasis in original. Otherwise, the rejection should be withdrawn.

For at least these reasons, independent claims 34 and 48 are patentable under 35 U.S.C. § 103(a) over Clinefelter.

Claim Rejections Under 35 U.S.C. § 103(a)—Dependent Claims

Applicants submit that dependent claims 35-37, 39-47 and 49-66 are also patentable under 35 U.S.C. § 103(a) over Clinefelter, at least due to the direct or indirect dependency of claims 35-37, 39-47 and 49-66 from independent claims 34 and 48.

Claim Rejections Under Obviousness-Type Double Patenting

Applicants respectfully traverse the Examiner’s double patenting rejection of claims 1, 34-37, 39, 43-54 and 61-66 over claims 1-21 of U.S. Patent No. 6,332,999 (the ‘999 patent) for at least the reasons set forth below. The Examiner asserts that although “the conflicting claims are not identical, they are not patentably distinct from each other because the previously issued US Patent –999 and the instant claims set forth a method and apparatus which are very similar to each other”. Office Action, p. 4. Specifically, the Examiner states that “the only differences in the claims of USP-999 and those of the instant application reside in the terminology used – i.e. exactly how the limitations are expressed.” Id. Applicants respectfully disagree.

In making an obviousness-type double patenting determination, the Examiner must focus only on the claims, while applying what is essentially the test for obviousness under 35 U.S.C. § 103. Therefore, the Examiner has the burden of showing that the claims of the ‘999 patent provide (1) a motivation to modify, (2) a reasonable expectation of success of the proposed

modification, and (3) a teaching or suggestion of all the claimed elements. See M.P.E.P. §§ 804, 2143.

Applicants respectfully submit that the Examiner has not met any of the criteria listed above. As above, independent claim 34 of the present invention recites among other things a preforming step, which is not recited in any claim of the '999 patent. Additionally, independent claim 48 requires, for example, a guide duct, which is also not recited in any claim of the '999 patent, and differs in more than just mere terminology. For at least this reason, Applicants respectfully request the Examiner to reconsider and withdraw the obviousness-type double patenting rejection.

#### Claim Scope

In discussing the specification, claims, abstract, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants believe that Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

#### Summary

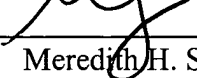
In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this Application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: July 28, 2004

By:   
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